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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,388	12/06/2001	Dean A. Klein	MTIPAT.073DV1	3167

20995 7590 12/02/2003

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EXAMINER

DINH, SON T

ART UNIT PAPER NUMBER

2824

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,388

Applicant(s)

KLEIN, DEAN A.

Examiner

son t dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The amendment A filed on 9/15/03 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2-7, 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwamoto et al (U.S. Patent No 5,764,590).

For the purpose of this rejection, "the input buffer register" would be considered as "the input buffer" as disclosed in the specification and the drawing, and an input/output terminal would be considered as a contact (as defined by the applicant),

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and a selector would be considered as a switch because this selector performs the function of connecting and disconnecting (enabling and disabling) a data bus from an input buffer.

Regarding claims 2-3, figure 9 (also see figure 11 for more detail) of Iwamoto et al discloses a memory device comprising a contact (112, 113) connects to a data bus (the bus that connected 112 or 113 to the switch 904 (selector)), a switch (904) having input connected to the contact 112 (or 113) and an output connected to an input buffer (905a, 905b). See column 12, lines 4-15.

Regarding claims 4-5, 7, element 501 (figure 5) is one control terminal, and 502 (figure 5) is a logic circuit that is configured to selectively open the switch 904 (figure 11). Also, elements 1101 and 1102 in figure 11 would be a control portion as claimed in claim 5.

Regarding claim 6, the circuit 103 in figure 10B of Iwamoto et al has one control terminal (ext/WE) for receiving memory access control signal (WE) and coupled to the control terminal 501.

Regarding claims 9-10, the switch 904 is a transfer gate and when input buffer 905a is not selected (no access is occurring), then the step of disabling is performed, and when input buffer a is selected (access is occurring), then the step of enabling is performed. The step of transferring data in claim 10 is performed by switch 904 (or transfer gate 904).

Regarding claim 11, for the purpose of this rejection, means for enabling and means for disabling would be considered as a single means that could perform both

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functions (see the 112 rejection above). Then switch 904 would be means for performing the function of enabling a transfer gate when there is an access, and disabling when there is no access. See the rejection applied to claims 9-10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamoto et al in view of Miyai et al (U.S. Patent No 5,537,584).

Iwamoto et al applied as above. The only difference between Iwamoto et al and claim 8 is that Iwamoto et al is silent on the use of circuit or a state decoder for generating a chip select signal. Miyai et al teaches that the use of a circuit (22 figure 8) for generating a chip select signal so as to enable the operation of the integrated circuit is well known in the art. The element 22 of Miyai et al would be considered as a state decoder since this circuit could perform the function of generating a chip select signal.

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Iwamoto et al by using a state decoder for generating a chip select signal which is applied to the integrated circuit so as to enable the operation of the integrated circuit as evidenced by Miyai et al.

Response to Arguments

The applicant argues that the selector of Iwamoto et al is not used for the purpose of controlling the parasitic capacitance of a bus. The Examiner disagrees. It is noted that the selector of Iwamoto et al function as a switch (connecting or disconnecting the bus from an input buffer), and such selector would perform the function of electrically isolating portions of a bus, then the selector inherently controls the parasitic capacitance on the bus. Note that the applicant agrees that by electrically isolating portions of a bus, the parasitic capacitance would be control.

Furthermore, the Examiner respectfully submits that the terminology "wherein" in the claims does not define any structure. It has been held that the functional "whereby" (or wherein) statement does not define any structure and accordingly cannot serve to distinguish. In *Re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

The applicant also argues that Miyai fails to teach the use of a chip select signal so as to control the parasitic capacitance of a bus. Note that claims 1 and 8 state that the switch is used for the purpose of controlling the parasitic capacitance of a bus, not the chip select signal itself. Therefore, the applicant is not directed to the ground of the 103 rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son t Dinh whose telephone number is 703-308-4120. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Elms can be reached on 703-308-2816. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Son T. Dinh
Primary Examiner

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S. Dinh

November 30, 2003